

Application Serial No.: 10/518,395
Attorney Docket No.: 08997.0005-00

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the amendments presented herein and the following remarks. Prior to entry of this response, claims 30-59 were pending in the application, of which claims 30, 34-38, 42, 44-48, and 59 are independent. In the Office Action dated June 6, 2007, the Examiner rejected claims 30-33, 36-37, 39-46, 49, and 58-59 under 35 U.S.C. §102(b), and rejected claims 34-35, 38, 46-48, and 50-56 under 35 U.S.C. § 103(a).¹ Following this response, claims 30-59 remain pending. Applicant hereby addresses the Examiner's objections and rejections in turn.

I. **Claim Amendments**

Claim 30 has been amended to recite, among other things, "placing a volume change compensation structural member into said cavity to maintain a compensating volume in said cavity in an area of non-critical electrical field as said insulating material is introduced into said cavity." Claims 36, 37, 38, 42, 44, 45, 47, and 59 have been similarly amended. Support for this amendment is found throughout the specification, which consistently refers to providing a volume change compensation member

¹ The Office Action indicates that claim 46, and not claim 45, is rejected under §102(b) as being anticipated by Evans. However, the Examiner's discussion of claim 46 at pages 7-8 of the Office Action refers to a hollow body member. Because this is a recitation of claim 45, not claim 46, Applicant believes that the Examiner's rejection under §102(b) applies to claim 45, and not claim 46. Similarly, the Office Action indicates that the Examiner rejected claim 45 under §103(a), but the discussion of claim 45 actually relates to claim 46. Accordingly, Applicant believes the §103(a) rejection applies to claim 46, not claim 45. The Office Action also indicates that claims 54 and 55 were rejected under §102(b) as being anticipated by Evans. Claims 54 and 55 depend, directly or indirectly, from claim 46. Thus, Applicant believes claims 54 and 55 are actually rejected under §103(a), and the rejection of those claims is addressed in Section II below.

Application Serial No.: 10/518,395
Attorney Docket No.: 08997.0005-00

comprising a structural member, such as a solid body (Spec. at 12), a foam body (*Id.* at 13), a hollow body (*Id.* at 15), an inflatable body (*Id.* at 16), or a compressible body (*Id.* at 15). Accordingly, Applicants respectfully assert that no new matter is introduced by these claim amendments.

II. Rejection of the Claims Under 35 U.S.C. §102(b)

In the June 6th Office Action, the Examiner rejected claims 30-33, 36-37, 39-45, 49, and 58-59 under 35 U.S.C. §102(b) as being anticipated by Patent No. GB 2 336 252 ("Evans").

Amended claim 30 recites, among other things,

placing a volume change compensation structural member into said cavity to maintain a compensating volume in said cavity in an area of non-critical electrical field as said insulating material is introduced into said cavity, said volume change compensation member having a predetermined volume to accommodate volume expansions of said insulating material within said cavity.

The Examiner asserts that Evans discloses "placing a volume change compensation member (12, air) into said cavity, wherein the volume change compensation member (12) is capable of maintaining a compensating volume in a cavity in an area of non critical electrical field as the insulating material is introduced into the cavity." OA at 3. For the reasons discussed in Applicant's December 6, 2006 Amendment, Applicant disagrees with the Examiner's characterization of the empty space 12 as a "member." However, in an effort to advance prosecution, Applicant has amended claim 30 to recite a "volume change compensation structural member." The empty space 12 (termed "air" by the Examiner) shown inside Evans' outer member 5 in Figure 1, is not a "volume change compensation structural member" as recited in claim 30 because empty space is not a "structural member." Because Evans does not teach

**Application Serial No.: 10/518,395
Attorney Docket No.: 08997.0005-00**

at least this structural recitation of claim 30, it does not anticipate claim 30, or claims 32-33 and 39-41, which depend from claim 1 and include each of its limitations. Applicant therefore respectfully requests that the rejection of claims 30, 32-33, and 39-41 be withdrawn.

The Examiner also rejected independent claims 36 and 45 as being anticipated by Evans. Claim 36 have been amended to recite, among other things, "placing a hollow body as a volume change compensation structural member into said cavity to maintain a compensating volume in said cavity in an area of non-critical electrical field as said insulating material is introduced into said cavity." Claim 45 has been similarly amended to recite "a hollow body as a volume change compensation structural member having a predetermined volume to ensure the accommodation of said volume expansions, said volume change compensation member being located in said cavity in an area of non-critical electrical field." As discussed above with regard to claim 30, the empty space 12 inside Evans' outer member 5 is not a volume change compensation structural member, so Evans does not anticipate claims 30 or 45.

Furthermore, Evans' empty space inside outer member 5 is not a hollow-bodied volume change compensation member as recited in claims 36 and 45. The Examiner asserts that Evans discloses a volume change compensation member (air) that is a hollow body. OA at 4. The Examiner also asserts that the empty space 12 is "a hollow void (i.e. hollow body member)." OA at 8. However, claims 36 and 45 specify that the volume change compensation member is located in a cavity inside the outer insulator body and an interior member. Evans does not disclose both an outer insulator body and a hollow-bodied volume change compensation member within the outer insulator

**Application Serial No.: 10/518,395
Attorney Docket No.: 08997.0005-00**

body. Instead, Evans simply discloses outer member 5 having empty space therein. Thus, lacking a hollow body as a volume compensation member inside outer member 5, Evans does not teach placing a "hollow body as a volume change compensation member into said cavity" as recited in claim 36 or "a hollow body as a volume change compensation member...located in said cavity in an area of non-critical electrical field" as recited in claim 45. Because Evans does not teach every recitation of claim 36 or claim 45, Applicant respectfully requests that the rejection of these claims be withdrawn.

Amended claim 37 recites, among other things, "placing a compressible body as a volume change compensation structural member into said cavity to maintain a compensating volume in said cavity in an area of non-critical electrical field as said insulating material is introduced into said cavity." Amended claim 44 similarly recites "a compressible body as a volume change compensation structural member having a predetermined volume to ensure the accommodation of said volume expansions, said volume change compensation member being located in said cavity in an area of non-critical electrical field." As discussed above with regard to claim 30, the empty space 12 inside outer member 5 does not constitute a volume change compensation structural member. Because Evans does not teach at least this recitation of claim 37 and claim 44, Applicant respectfully requests that the rejection of these claims be withdrawn.

The Examiner also rejected claim 42 as being anticipated by Evans. Amended claim 42 recites, among other things, "a volume change compensation structural member having a predetermined volume to ensure the accommodation of said volume expansions, said volume change compensation member being located in said cavity in an area of non-critical electrical field." As discussed above with regard to claim 30, the

Application Serial No.: 10/518,395
Attorney Docket No.: 08997.0005-00

empty space 12 inside Evans' outer member 5 is not a volume change compensation structural member as recited in claim 42. Because Evans does not teach at least this limitation of claim 42, Applicant respectfully requests that the rejection of claim 42, as well as claims 43 and 49, which depend from claim 42, be withdrawn.

The Examiner also rejected claim 59 as being anticipated by Evans. Amended claim 59 recites, among other things, "placing a volume change compensation structural member into said cavity." Claim 59 also recites, among other things, "removing said volume change compensation structural member after filling said insulation material into said cavity." As discussed above with regard to claim 30, Evans does not disclose this recitation because empty space 12 is not a volume change compensation structural member as recited in claim 59. Furthermore, claim 59 also recites "removing said volume change compensation member after filling said insulation material into said cavity." The Examiner asserts that Evans discloses this recitation, alleging that "after the termination is placed in the field and the termination heats up the insulation material will expand into the open space thereby removing the air from the termination." OA at 9. However, even if the claimed "structural member" were somehow construed to read on air, the Examiner has pointed to nothing in Evans disclosing that air contained in empty space 12 is removed from the termination when the insulation material expands. In fact, the Examiner acknowledges that Evans discloses sealing the termination. OA at 3. Accordingly, the air in empty space 12 would not escape the termination when the insulation expands. For at least these reasons, Evans does not anticipate claim 59 and Applicant respectfully requests that the rejection be withdrawn.

Application Serial No.: 10/518,395
Attorney Docket No.: 08997.0005-00

III. Rejection of the Claims Under 35 U.S.C. §103(a)

The Examiner rejected claims 34-35, 38, 46-48, and 50-56 under 35 U.S.C. §103(a) as being obvious over Evans in view of U.S. Patent No. 6,235,992 ("Abisso").

To establish a *prima facie* case of obviousness of these claims, there must be some suggestion or motivation to combine reference teachings. MPEP §2143. Prior art references must be considered as a whole, including portions that would lead away from the claimed invention. MPEP §2141.02(VI); *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.3d 1540 (Fed. Cir. 1983). Furthermore, "if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification." MPEP §2143.01(V); *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

Here, Abisso teaches away from Applicant's claimed invention, and therefore cannot properly be combined with Evans to establish a *prima facie* case of obviousness. Each of claims 34-35 and 38 recites, among other things, "placing...a volume change compensation member into said cavity to maintain a compensating volume in said cavity in an area of non-critical electrical field as said insulating material is introduced into said cavity." Claims 50-53 depend, either directly or indirectly, from claim 45, which includes the same recitation. Similarly, claims 46-48 each recite, among other things, "a volume change compensation member having a predetermined volume to ensure the accommodation of said volume expansions, said volume change compensation member being located in said cavity in an area of non-critical electrical field." Claims 56 and 57 depend, either directly or indirectly, from claim 47.

Application Serial No.: 10/518,395
Attorney Docket No.: 08997.0005-00

In its Background of the Invention, Abisso describes "compensating volumes" used in prior art devices as a "drawback." Col 1, lines 28-39. To overcome this "drawback," Abisso sought to "realise an electrical device...having improved compressibility in order to be applicable within a wide functioning temperature range without requiring compensating volumes." Abisso at 2:25-30 (emphasis added). Indeed, the July 6th Office Action noted that Abisso does not use compensating volumes. 7/6/06 OA at 11. Because Abisso teaches away from the use of compensating volumes, there is no motivation to combine Evans and Abisso. See MPEP §2145(X)(D)(2) ("It is improper to combine references where the references teach away from their combination."). Moreover, modifying Abisso to place a volume change compensation member in an area of non-critical electrical field would render it unsuitable for its purpose of providing an electrical device without requiring compensating volumes. Thus, Abisso teaches away from the modification suggested by the Examiner.

Furthermore, Abisso provides an insulating filler comprising a compressible silicone-based composition that saturates free volumes in electrical devices such as a termination. Abisso discloses that its insulating filler is superior to insulating materials such as those disclosed in Evans because it has an optimum adhesion and does not suffer from the leakage problems common with other insulating fillers known in the art. Abisso at 1:32-60; 2:25-57. Thus, one of ordinary skill in the art would not be motivated to combine Abisso and Evans in the manner suggested by the Examiner since Abisso teaches that its insulating material is superior to fillers such as that disclosed in Evans. If anything, one of ordinary skill in the art would be motivated to replace Evans' insulating filler with that of Abisso, which saturates the free volume of the termination

Application Serial No.: 10/518,395
Attorney Docket No.: 08997.0005-00

without leaving a compensating volume. For this further reason, Evans cannot be combined with Abisso in the manner suggested by the Examiner.

Because Abisso teaches away from the modification proposed by the Examiner, and because such modification would render Abisso unsuitable for its intended purpose, the Examiner has not established a *prima facie* case of obviousness. Applicant therefore respectfully requests that the Examiner withdraw the rejection of the claims under 35 U.S.C. §103(a).

IV. Conclusion

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art not specifically discussed herein. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

**Application Serial No.: 10/518,395
Attorney Docket No.: 08997.0005-00**

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 9, 2007

By: 

Cortney S. Alexander
Reg. No. 54,778